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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,196	10/28/1999	STEVEN D. FAUST	V5735	5642

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EXAMINER

RAHIMI, IRAJ A

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 10/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/429,196

Applicant(s)

FAUST ET AL.

Examiner

(Iraj) Alan Rahimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Drawings

1. Figure numbers 7, 8, 9, 10 and 13 are missing on the drawings. Appropriate correction is required.

Response to Amendment

Applicant amended the claims by adding the "electronic graphic " to the template to distinguish the type of template. As stated in the specification on page 8, 1st paragraph, PageMaker graphics software is used for creating, designing, storing, accessing and updating a template. Therefore electronic graphic template echoes the features of the commercially available software, which is not patentable.

Response to Arguments

2. Applicant's arguments filed on July 16, 2002 have been fully considered but they are not persuasive.

Regarding claim 1, applicant argued that Freedman did not teach every element of the claim. In contrast Freedman does teach every element of the claim as further explained below. Applicant stated that there is no means to update Freedman's templates. Column8, lines 21-27 teach that computer 20 asks the user to select a printing parameter design template, which may have been previously established or may elect to enter printing parameters to establish new custom design template. The act of creating new templates is considered a form of updating.

Additionally, applicant is claiming a feature (updating feature) of the PageMaker graphic software as admitted on page 8, 1st paragraph of the specification. What is admitted, as features of the commercially available software cannot be claimed as part of applicant's invention.

Applicant also stated that Freedman does not teach a means to design or program a database file. Freedman in column 8, lines 56-68 states that customer can create a custom design format and select various characteristics associated with the design of the template.

Applicant also stated that Freedman's batch uploading of the data is not a means for automatically populating the data into the electronic graphic template. Although this interpretation can be further discussed more technically, examiner prefers to take applicant's attention to the specification on page 12, the last two lines, where applicant admits that "The data is automatically imported, filed by field, into the customer's data base file using combination of Apple Script and FileMaker Pro script programming". What is admitted, as features of the commercially available software cannot be claimed as part of applicant's invention.

Applicant lastly stated that Freedman's use of the word "format" refers to general template formats (books, newsletter, etc.), not typesetting formats based on corporate identity specification. Freedman specifically teaches in column 8, lines 56-68 ability to select a custom design format. He also teaches ability to select typeface, point size, character per pica, etc., which are all various formatting elements.

Regarding claim 2, applicant added the "electronic graphic " to the template to distinguish the type of template. As stated in the specification on page 8, 1st paragraph, PageMaker graphics software is used for creating, designing, storing, accessing and updating a

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template. Therefore electronic graphic template echoes the features of the commercially available software, which is not patentable. Applicant additionally amended the claim by adding, "production-ready output". Freedman teaches in column 7, lines 58-61 that printing requester or user transmits the stored information to the printing facility for printing the work. Therefore, if the printing facility's role is to print, it means that they receive the print ready information for printing.

Regarding claims 3-9, applicant argues that these claims are patentable because of their dependency on claims 1 or 2. Claims 3-9 remain rejected as set forth in the 1st office action and based on the rejection of amended claims 1 and 2.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829).

Regarding claim 1, Freedman discloses an automated typesetting system used for production of a commercially-printed product according to a customer's corporate identity specifications, comprising:

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means for creating, designing, storing, accessing, and updating an electronic graphic template of the product according to the customer's corporate identity specifications (Fig. 1A; column 8, lines 21-45 & 56-68);

means for creating, designing, programming, storing, accessing, and updating an electronic database file, wherein said database file is programmed to receive and store populating data used to populate said template and said database file is further programmed with instructions and parameters used to format said populating data on said template according to the customer's corporate identity specifications (column 7, lines 37-52); means for inputting said populating data into said database file as database records (Figure 1A, terminals 14 and 38) ; means for automatically populating said populating data into said template (column 8, lines 45-48); and means for automatically formatting said populating data on said template according to the customer's corporate identity specifications to form a populated and formatted template (column 8, lines 40-44). Freedman refers to the programmed computer 20 for storage of database containing the information for a job. The programmed computer also holds the software for running this application.

Regarding claim 2, Freedman discloses an automated typesetting system of claim 1 further comprising a means for automatically printing said populated and formatted template (column 7, lines 58-61).

Regarding claim 3, Freedman discloses an automated typesetting system of claims 1 or 2, in which said template is comprised of at least one block designed to contain populating data in

the form of text or graphics. In column 8, lines 36-44 Freedman teaches different manuscript formats like book and newsletter. Such formats allow for text and graphics. He also teaches accepting scanned graphics in column 8, lines 19-21.

Regarding claim 4, Freedman discloses an automated typesetting system of claims 1 or 2, in which said database file is comprised of at least one field designed to contain populating data and at least one field designed to contain instructions and parameters used to format said populating data on said template according to the customer's corporate identity specifications. Freedman considers in column 7, lines 37-58 all parameters for printing a job. Such parameters in the printing environment include data and format information.

Regarding claim 5, Freedman discloses an automated typesetting system of claims 1 or 2, in which said means for creating, designing, storing, accessing, and updating an electronic graphic template comprises a computer software program and said means for creating, designing, programming, storing, accessing, and updating an electronic database file comprises a computer software program (column 3, lines 57-62). The programmed computer 20 contains the software/program for executing the function described in his invention.

Regarding claim 7, Freedman discloses an automated typesetting system of claims 1 or 2 further comprising a means for electronically proof checking and correcting said populating data prior to automatically populating said populating data into said template (column 9, lines 18-22).

Regarding claim 8, Freedman discloses an automated typesetting system of claims 1 or 2, in which said means for automatically populating said populating data into said template further comprises a means for fully populating said template should said populating data not fully populate said template (column 11, lines 36-38). Freedman also teaches that print manager has the ability to add additional information in the computer such as special stock dimension, color or plate size to complete the job.

Regarding claim 9, Freedman discloses an automated typesetting system of claims 1 or 2 interactively coupled with an automated order tracking, billing, shipping, and inventory control system (column 8, lines 1-9; column 10, lines 15-24, 36-38, 55-63; column 11, lines 1-50).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman in view of Cupps et al. (U.S. Patent 5,991,739).

Regarding claim 6, Freedman does not disclose an automated typesetting system of claims 1 or 2, in which said means for inputting said populating data into said database file as database records comprises:

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a Web site programmed to receive said populating data; and a populating data import means for automatically importing said populating data into said database file as database records.

Cupps et al. discloses an Internet on line order service wherein a customer is given access to a web site to facilitate ordering (column 2, lines 19-38; column 4, lines 60-68 and column 5, lines 1-5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to modify Freedman wherein the on-line communication link is the Internet. It would have been obvious to a person skilled in the art to combine teaching of Cupps et al. with Freedman et al. to provide customers with greater access to the system from remote locations.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraq) Alan Rahimi whose telephone number is 703-306-3473.


The examiner can normally be reached on Mon.-Fri. 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

AR

September 27, 2002


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600